

## REMARKS

### **1. Status of Claims**

The final Office Action of June 30, 2004 rejects the 35 U.S.C. § 103(a) arguments found in Applicant's Response to First Office Action dated April 20, 2004. The rejection has the effect of maintaining the same rejections relating to claims 1-10 as found in the Office Action of January 20, 2004. Claims 1-10 are pending. Applicant respectfully submits that all claims are in condition for allowance based on the reasons found below.

### **2. Disqualification of Leary (U.S. Patent No. 6,425,133) as Prior Art under § 103(c)**

Applicant respectfully submits that U.S. Patent No 6,425,133 to Leary ("Leary") should be disqualified as prior art.

35 U.S.C. § 103(c) states, in relevant part, that subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of § 102, shall not preclude patentability where the subject matter and claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

In response to Applicant's statement that the invention of U.S. Application No. 09/735,676 and Leary were, at the time the invention of U.S. Application No. 09/735,676 was made, owned by or subject to an obligation of assignment to the same entity, Examiner stated that Examiner possesses independent evidence that raises doubts as to the accuracy of such statement. Thus, Examiner did not disqualify Leary because "Leary does not appear to be owned by or subject to an obligation of assignment to Motorola, Inc. at the time the invention was made." Accordingly, Examiner requested objective evidence directed to the accuracy of Applicant's statement in order to disqualify Leary.

In accordance with Examiner's request, Applicant submits herewith a Certificate of Merger filed in the State of Delaware evidencing an Agreement and Plan of Merger, dated

September 14, 1999, among Motorola, Inc., Lucerne Acquisition Corp. (a wholly owned subsidiary of Motorola, Inc.) and General Instrument Corporation (see Exhibit A).

Furthermore, Applicant submits herewith a Registration Statement filed with the Securities and Exchange Commission on November 29, 1999 of the Agreement and Plan of Merger among Motorola, Inc., Lucerne Acquisition Corp. and General Instrument Corporation (see Exhibit B).

The date that the subject matter of the present invention was made, namely, December 14, 1999, is after the date of the Agreement and Plan of Merger among Motorola, Inc., Lucerne Acquisition Corp. and General Instrument Corporation, namely, September 14, 1999. Accordingly, Leary should be disqualified as prior art because U.S. Application No. 09/735,816 and Leary were, at the time the invention of U.S. Application No. 09/735,816 was made, owned by or subject to an obligation of assignment to Motorola, Inc.

**3. § 103(a) Rejections**

Although the final Office Action rejects claims 1-14 under 35 U.S.C. § 103(a) as being obvious over Leary in view of U.S. Patent No. 5,990,927 to Hendricks et al., Applicant believes this rejection is improper because only ten (10) claims are pending in the current application. As such, Applicant is responding to the § 103(a) rejections found in the Office Action of January 20, 2004 as though they were restated in full in the final Office Action.

**4. § 103(a) Rejection Over Leary (U.S. Patent No. 6,425,133) in View of Bacon et al. (U.S. Patent No. 5,440,632)**

Claims 1-3 and 10 stand rejected under 35 U.S.C. § 103(a) as being obvious over Leary in view of U.S. Patent No. 5,440,632 to Bacon et al. ("Bacon").

The three basic criteria for establishing a prima facie case of obviousness, set forth in MPEP § 706.02(j), are listed below:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the

reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits that the criteria mentioned above are not met because Leary is disqualified as prior art under § 103(c). To use a disqualified reference as a primary reference when combining references in an obviousness rejection is tenuous at best.

Therefore a *prima facie* case of obviousness has not been established. Accordingly, claims 1-3 and 10 are not rendered obvious for at least the reasons set out above and are patentable.

**5. § 103(a) Rejection Over Leary (U.S. Patent No. 6,425,133) in View of Bacon et al. (U.S. Patent No. 5,440,632) in Further View of Hendricks et al. (U.S. Patent No. 5,990,927)**

Claims 4 and 7 stand rejected under 35 U.S.C. § 103(a) as being obvious over Leary in view of Bacon in further view of U.S. Patent No. 5,990,927 to Hendricks et al. ("Hendricks").

Applicant respectfully submits that a *prima facie* case of obviousness has not been established because Leary is disqualified as prior art under § 103(c) and using a disqualified reference as the primary reference when combining references is tenuous at best.

Consequently, claims 4 and 7 are not rendered obvious for at least the reasons set out above and are patentable.

**6. § 103(a) Rejection Over Leary (U.S. Patent No. 6,425,133) in View of Bacon et al. (U.S. Patent No. 5,440,632) in Further View of Hendricks et al. (U.S. Patent No. 5,990,927) and in Further View of Wagner et al. (U.S. Patent No. 5,761,602)**

Claims 5, 6, 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being obvious over Leary in view of Bacon in further view of Hendricks and in further view of U.S. Patent No. 5,761,602 to Wagner et al.


Again, Applicant respectfully submits a *prima facie* case of obviousness has not been established because Leary is disqualified as prior art under § 103(c) and using a disqualified reference as the primary reference when combining references is tenuous at best. Therefore, claims 5, 6, 8 and 9 are not rendered obvious for at least the reasons set out above and are patentable.

### **CONCLUSION**

It is respectfully submitted that all claims in the application are now allowable. Reconsideration and withdrawal of the pending rejections are respectfully requested. Early and favorable notice to this effect is earnestly solicited.

If the Examiner does not consider all of the pending claims allowable, the undersigned respectfully requests an interview with the Examiner to discuss the merits of the case.

Respectfully submitted,



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